

REMARKS

The Examiner rejected claims 19-21 under 35 USC § 112 for not providing appropriate antecedent basis for the term “contest entry number”. By this amendment, claims 19 and 20 have been amended to be dependent upon claim 18 which provides appropriate antecedent basis for contest entry number. Accordingly it is respectfully submitted that this rejection is no longer applicable.

The Examiner has also rejected claims 1, 2, 7, 8, 10, 11, 13-17, 22, 23, 25, 26, 28-33 under 35 USC § 103(a) as being unpatentable over Tsubaki et al. (US 5,815,138) in view of Small (US 5,791,991) for the reasons set forth therein. Applicant respectfully submits that these claims are patentable over the cited art. In particular, Tsubaki does not teach or suggest incorporating a personal image into a game. Tsubaki discloses use of a CD-I with an ordinary television set upon which image data and an application program can be used to play a game. There is also disclosed a photo CD system that allows placement of personal images on a disk. The CD-I and CD are two separate and distinct products and pieces of prior art. The reference to CD-I disk is described as an illustrative example whereby a user may play a game on a TV that utilizes images. However, there is no teaching or suggestion that the CD-I incorporate personal images.

The reference to photo CD is a totally separate and distinct reference that simply discloses the providing of images on a writable compact disk (CD-R). There is no teaching or suggestion that a game could be played with the personal images provided on the photo CD. As set forth at column 1, lines 34-35, the image on the CD-R is simply shown on a display such as home TV receiver. These two references were cited in the Tsubaki et al. reference as illustrating means for searching for images on a CD-I or photo CD by manipulating a mouse, joy stick or similar conventional pointing device. The Tsubaki reference is directed to method and apparatus for controlling movement of a cursor in such a manner as to promote easy and accurate selection of a function button out of a plurality of function buttons appearing on a screen. There is no teaching or suggestion in Tsubaki which enables the user to play a game utilizing an image provided by a user.

MPEP 706.02(j) states:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - §2143.03 for decisions pertinent to each of these criteria.

“The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’ *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.”

As set forth in MPEP 706.02(j) there must be a teaching or suggestion of all the claim limitations and the initial burden is on the Examiner to provide some suggestion or the desirability of doing what the inventor has done.

In the present instance, the Tsubaki reference is directed to providing means for controlling movement of a cursor. The reference to a CD-I and photo CD is only ancillary and is directed simply to disclosing that products are out there whereby cursors are used to find images. As previously discussed, the CD-I does not teach or suggest the incorporating of an image provided by a user with regard to the game and the photo CD product does not teach or suggest of providing a game. There is no teaching or suggestion utilizing digital images supplied by user and incorporating such into a game. Further, the Tsubaki reference fails to teach or suggest the automatic displaying prestored messages to the user upon playing or completion of the game. Since the Tsubaki reference is directed to providing an improved cursor, there would be no teaching, suggestion or motivation to make such a modification.

The Examiner relies on the Small reference for teaching of providing discount coupons or rebate information at the conclusion of the game.

However, as previously discussed and acknowledged by the Board of Appeals in the subject application, the images provided by Small are provided by the advertiser and not by the user. Thus, neither of the cited references teach or suggest the utilization of user supplied images in the playing of the game. Accordingly, Applicant respectfully submits that independent claim 1 is patentably distinct for the foregoing reasons.

Dependent claim 2 is dependent upon independent claim 1 and further includes the limitation that the computer program is automatically forwarded to a remote computer site upon playing or completion of the game. Since the Small reference requires the user to already be at the site, there is no teaching or suggestion of forwarding to a remote computer site upon completion of the game as set forth in dependent claim 2, nor does Small teach or suggest the verifying of a contest number as set forth in claims 3 and 4. Clearly, the prior art fails to teach or suggest the invention as taught and set forth in these dependent claims.

Claim 17 is a computer software product similar to claim 1 and is therefore patentably distinct for the same reasons previously discussed. In addition, dependent claims 18, 19 and 20 are similar to claims 2, 3 and 4 and therefore are also patentably distinct for the additional reasons previously discussed.

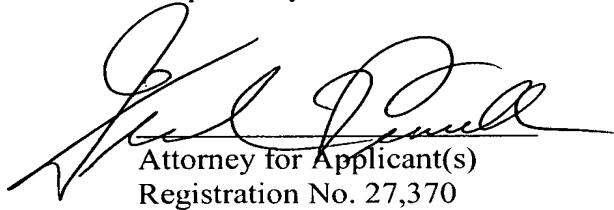
Claim 32 is similar to independent claim 1 and that is directed to computer software product comprising a computer readable storage medium having a computer program, which when loaded on a personal computer, causes the personal computer to perform the steps of locating and selecting at least one digital image supplied by a user and provided on a storage medium and automatically forwarding the user on the personal computer to a remote site upon a predetermined action for viewing a product advertisement by the user. This is not taught or suggested by either of the cited references. The Examiner has alternatively rejected claims 1, 11 and 16 under 35 USC § 103(a) as being unpatentable over Tsubaki in view of Bernstein et al (US 4,314,336) for the reasons set forth there. The Bernstein reference is no more relevant than the Small reference. In fact, the Bernstein reference is less relevant than the Small reference in that the Bernstein reference simply discloses a score as a result of playing a game. There is no teaching or suggestion of utilizing a personal image

in the game, nor does it teach or suggest automatically forward the user to a remote computer site or the use of a contest entry number that can be verified as taught and claimed by Applicant. Accordingly, it is respectfully submitted that claim 1 and the dependent claims are patentably distinct for the same reasons previously discussed.

With regard to claim 3-6, 18-21 which have been rejected under 35 USC § 103(a) as being unpatentable over Tsubaki et al. in view of Small and Walker et al., it is respectfully submitted that these dependent claims are patentably distinct for the reasons previously discussed. The additional reference to Walker et al. does not teach or suggest anything that would render the independent claims obvious for the reasons previously discussed. Likewise, the additional reference of Barnett et al. (US 6,336,099) and Von Kohorn (US 5,916,024) fail to teach anything that would render the independent claims, upon which they ultimately depend, obvious.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



Frank Pincelli
Attorney for Applicant(s)
Registration No. 27,370

Frank Pincelli/phw
Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.